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001

ATTORNEY CONFIDENTIAL

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2111 Ne 25<sup>th</sup> Avenue, MS: JF3-147  
Hillsboro, Oregon 97124

Intel Legal Team

Fax

Page 1 of 18

Urgent

Confidential

Date: 15-May-06

To:  
Examiner: Vig, Naresh  
USPTO

Fax:  
(571)-273-8300

Art Unit:  
3629

From:  
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Intel Corporation

Fax:  
503-264-1729

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JF3-147

Subject: Application No.: 09/275,514    Docket #: P7034  
Filed: March 24, 1999    Inventor: Matthew Holliman

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Transmittal Form (1 page)  
Fee Transmittal (1 page submitted in duplicate)  
Reply Brief in Support of Appeal (14 page)

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**TRANSMITTAL  
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Application Number

09/275,514

Filing Date

March 24, 1999

First Named Inventor

Matthew Holliman

Art Unit

3629

Examiner Name

Vig, Naresh

Attorney Docket Number

P7034

**ENCLOSURES** (Check all that apply)

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Reply to Missing Parts/  
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Drawing(s)



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Petition



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- Reply Brief in Support of Appeal
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Remarks

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/s/Justin B. Scout/ Reg. No. 54,431/

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Justin B. Scout

Date

May 15, 2006

Reg. No.

54,431

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PTO/SB/17 (12-04v2)

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**FEE TRANSMITTAL**  
**For FY 2005**☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 0.00

**Complete if Known**

Application Number	09/275,514
Filing Date	March 24, 1999
First Named Inventor	Matthew Holliman
Examiner Name	Vig, Naresh
Art Unit	3629
Attorney Docket No.	P7034

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES****Fee Description**

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Fee (\$)	Small Entity Fee (\$)
50	25
200	100
360	180

<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
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- 20 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of total claims paid for, if greater than 20.

<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
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- 3 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

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**3. APPLICATION SIZE FEE**

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<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
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**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): \_\_\_\_\_

**Fees Paid (\$)****SUBMITTED BY**

Signature	/s/Justin B. Scout/ Reg. No. 54,431/	Registration No. (Attorney/Agent) 54,431	Telephone 503-264-7002
Name (Print/Type)	Justin B. Scout		Date May 15, 2006

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PTO/SB/17 (12-04v2)

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Effective on 12/09/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

**FEE TRANSMITTAL**  
**For FY 2005**☐ Applicant claims small entity status. See 37 CFR 1.27TOTAL AMOUNT OF PAYMENT (\$)  
0.00**Complete if Known**

Application Number 09/275,514  
 Filing Date March 24, 1999  
 First Named Inventor Matthew Holliman  
 Examiner Name Vig, Naresh  
 Art Unit 3629  
 Attorney Docket No. P7034

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Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
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- 20 or HP = _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20.		
<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>
- 3 or HP = _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3.		

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If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets \_\_\_\_\_ Extra Sheets \_\_\_\_\_ Number of each additional 50 or fraction thereof \_\_\_\_\_ Fee (\$)  
 \_\_\_\_\_ - 100 = \_\_\_\_\_ / 50 = \_\_\_\_\_ (round up to a whole number) x \_\_\_\_\_ = \_\_\_\_\_ Fee Paid (\$)

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): \_\_\_\_\_

Fees Paid (\$)

**SUBMITTED BY**

Signature	/s/Justin B. Scout/ Reg. No. 54,431/	Registration No. (Attorney/Agent) 54,431	Telephone 503-264-7002
Name (Print/Type)	Justin B. Scout	Date May 15, 2006	

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Appl. No. 09/275,514

Attorney Docket: 042390.P7034

In The United States Patent and Trademark Office  
Before The Board of Patent Appeals and Interferences

In re Patent Application of:	)	Examiner:	Vig, Naresh
	)		
Holliman, <i>et al.</i>	)	Art Unit:	9862
	)		
Application No.: 09/275,514	)		
	)		
Filed: March 24, 1999	)		
	)		
For: PARTIAL PROTECTION	)		
OF CONTENT	)		

**REPLY BRIEF**  
**IN SUPPORT OF APPELLANTS' APPEAL**  
**TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Honorable Director of the United States Patent and Trademark Office  
Washington, DC 20231

Sir/Madam:

Pursuant to 37 C.F.R. § 41.41, Appellants submit this reply brief, in response to the  
Examiner's Answer mailed March 13, 2006.

All arguments in Appellants' Appeal Brief, filed December 12, 2005, are herein  
incorporated into this Reply Brief.

Appl. No. 09/275,514

Attorney Docket: 042390.P7034

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**1. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The above referenced patent application has been reviewed in light of the Examiner's Answer, dated March 13, 2006, in which the previous grounds for rejection are maintained. No new grounds for rejection have been added.

The grounds for rejection are as follows:

- claims 1-16, and 19-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis *et al.* (hereafter, 'Lewis,' US Patent No. 6,385,388 B1) in combination with Hsu (US Patent No. 6,195,692 B1) in further combination with DirecTV;
- and claims 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis in combination with Hsu and DirecTV in further combination with DirecTV in further combination with "Ratings, Filters, and Censorship" by Gary Robson (hereafter, 'Robson').

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## 2. RESPONSE TO EXAMINER'S ANSWER

### 2.1. 35 U.S.C. § 103(a)

#### 2.1.1. Lewis, Hsu, and DirecTV: Claims 1-16, and 19-32

The PTO has also rejected claims 1-16, and 19-32 under 35 U.S.C. § 103(a) based upon Lewis and Hsu in combination with DirecTV. The rejection of these claims is respectfully traversed.

M.P.E.P. § 706.02(j) sets forth the standard for a § 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (whitespace added).

Appellants begin with claim 1. Claim 1 recites:

1. (Previously Presented) A method of providing content to a receiving device having an associated identifier associated with a network address for the receiving device, comprising:  
 selecting a set of segments of content from a group of segments to be protected wherein the set does not include all segments of the group;  
 protecting the segments of the set, but not the other segments of the group, to prevent the protected segments from being properly reproduced unless the protection is undone with assistance of a correct key that is not generally available and is based at least in part on the associated identifier; and  
 providing access to the group of segments over a network.

Appellants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

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Attorney Docket: 042390.P7034

It is respectfully asserted that neither Lewis, Hsu, nor DirecTV, either alone or in combination, suggests or describes protecting and unprotecting the segments utilizing a correct key that is ... based at least in part on the identifier associated with a network address for the receiving device. See, claim 1, lines 2, 7, & 8. The PTO asserts that the DirecTV teaches this limitation. However, it is respectfully asserted that DirecTV does **not** teach this limitation.

### 2.1.1.1 Improper Rejection

It is respectfully asserted that the PTO has made an improper § 103 rejection of these claims.

M.P.E.P. § 706.02(j) details the contents of a proper 35 U.S.C. §103 rejection. (emphasis added)

#### 706.02(j) Contents of a 35 U.S.C. 103 Rejection

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.



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It is respectfully asserted that the PTO has failed to make a case for the first and second elements of a prima facie § 103 rejection. M.P.E.P. § 706.02(j) goes on to state "[t]he initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done." It is respectfully asserted that the PTO has made no attempt to make explain (1) what "suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" or (2) why the PTO feels that there is a "reasonable expectation of success" of combining the references. Furthermore, it is pointed out by M.P.E.P. § 706.02(j) that the suggestion to make the claimed combination must be found within the prior art references themselves.

M.P.E.P. § 706.02(j) states that in a proper § 103 rejection the examiner should set forth in the Office action "(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification." It is respectfully asserted that the PTO has not made these explanations nor attempted to fulfill the first and second elements (a suggestion to combine, and expectation of success, respectively) of a proper § 103 rejection. Therefore, it is respectfully asserted that the rejection of these claims is improper and should be withdrawn.

#### **2.1.1.2 Response to Examiner's Argument**

In section 10: "Response to Argument" of the Examiner's Answer, dated March 13, 2006, the Examiner claims that Appellants are not arguing positive limitations of the claims. Appellants respectfully disagree, and are concerned that their arguments appear to be so misunderstood. Appellants assume this is due to lack of clarity on their part and will attempt to

Appl. No. 09/275,514

Attorney Docket: 042390.P7034

clarify their arguments. Appellants feel that they are arguing limitations clearly found within the claims.

Appellants begin with claim 1. Claim 1 recites:

1. (Previously Presented) A method of providing content to a receiving device having an associated identifier associated with a network address for the receiving device, comprising:  
 selecting a set of segments of content from a group of segments to be protected wherein the set does not include all segments of the group;  
 protecting the segments of the set, but not the other segments of the group, to prevent the protected segments from being properly reproduced unless the protection is undone with assistance of a correct key that is not generally available and is based at least in part on the associated identifier; and  
 providing access to the group of segments over a network.

Appellants argue that neither Lewis, Hsu, nor DirecTV, either alone or in combination, suggests or describes protecting and unprotecting the segments of the set utilizing a correct key that is ... based at least in part on the identifier associated with a network address for the receiving device. See, claim 1, lines 2, 7, & 8.

The PTO asserts that the DirecTV teaches this limitation. Specifically, on page 4 of the Examiner's Answer dated March 13, 2006, the PTO states:

Lewis in view of Hsu does not teach protected segments from being properly reproduced unless the protection is undone with assistance of a correct key that is not generally available and is based in part on the associated identifier. However, DirecTV teaches system and method for protected segments from being properly reproduced unless the protection is undone with assistance of a correct key that is not generally available and is based at least in part on the associated identifier (users can view information provided by DirecTV after the user activates the access card received from DirecTV [DirecTV page 15]).

However, it is respectfully asserted that DirecTV does **not** teach this limitation. See Appeal Brief.

Appellants further argue that based upon DirecTV it is impossible to tell exactly what DirecTV is doing (which makes DirecTV an improper reference because it does not meet the § 103 requirement to "teach or suggest all the claim limitations") but that based on reasonable

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speculation (speculation, which is not permitted under § 103) it is unlikely that DirecTV encodes (*i.e.* protects) their broadcast in such a way that there is a key associated with either a network address or an identifier on each card. See Appeal Brief.

Appellants now address the PTO's remarks. Unless otherwise stated all page references are in regard to the Examiner's Answer dated March 13, 2006.

***2.1.1.2.1 Page 19, 4<sup>th</sup> paragraph and page 20, 1<sup>st</sup> paragraph***

The PTO claims that Appellants are arguing limitations not positively claimed. Appellants respectfully disagree.

Appellants fail to understand the relevance of the PTO's discussion of "protected" versus "scrambling". The only references Appellants can find to "scramble" or "scrambling" in the Appeal Brief, dated December 12, 2005, are in regards to the discussion on Official Notice, which the PTO stated on page 19, 3<sup>rd</sup> paragraph was withdrawn. Therefore, Appellants respectfully contend that this discussion by the PTO is irrelevant.

***2.1.1.2.2 Page 20, 2<sup>nd</sup> & 3<sup>rd</sup> paragraphs***

The PTO claims that Appellants are arguing limitations not positively claimed. Appellants respectfully disagree.

Appellants respectfully assert that the "correct key" is "based at least in part on the associated identifier" "associated with a network address for the receiving device". Claim 1, lines 7 & 8, clearly states that the correct key must be both "not generally available" and "based at least in part on the associated identifier". If the PTO has an alternate claim interpretation, it

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has not been stated or shown why such a claim interpretation is reasonable under M.P.E.P. §2111.

Furthermore, claim 1, line 2 states that the "associated identifier [is] associated with a network address for the receiving device". Appellants assert that claim 1 must be read as a whole and that any limitation imposed upon the associated identifier in line 2 are still on the associated identifier in lines 7 & 8, unless otherwise stated in the claim. Therefore, Appellants respectfully contend that a "correct key ... based at least in part on the associated identifier" "associated with a network address for the receiving device" is, in fact, a positive limitation (claim 1, lines 7 & 8, and line 2, respectively).

***2.1.1.2.3 Page 20, 4th paragraph and page 21, 1st paragraph***

The PTO claims that Appellants are arguing limitations not positively claimed. Specifically, the PTO states "appellant does not positively claim that the protection is done using a correct key associated with the receiving device." Appellants respectfully disagree.

As previously stated Appellants respectfully contend that a "correct key" "based at least in part on the associated identifier" "associated with a network address for the receiving device" is, in fact, a positive limitation. See claim 1, lines 2, 7 & 8.

Appellants respectfully assert that if the correct key is "based at least in part on the associated identifier" (claim 1, lines 7 & 8) and that the "associated identifier [is] associated with a network address for the receiving device" (claim 1, line 2) that the correct key must also be, at least in part, associated with the receiving device.

Therefore, Appellants respectfully contend that they are discussing a positive limitation.

Appl. No. 09/275,514

Attorney Docket: 042390.P7034

**2.1.1.2.4 Page 21, 2<sup>nd</sup> & 3<sup>rd</sup> paragraphs**

The PTO claims that Appellants are arguing limitations not positively claimed. Appellants respectfully disagree.

Specifically, the PTO states in the 4<sup>th</sup> paragraph "appellant does not positively claim that the protection is done using a correct key associated with the receiving device." Appellants respectfully contend that they are discussing a positive limitation. See the discussion directly above.

Furthermore, page 21, 3<sup>rd</sup> paragraph concerns Appellants' arguments as to what DirecTV shows. As Appellants argue that DirecTV does not meet the claim limitations, what DirecTV shows would of course not meet the positive limitations of Appellants claim. Appellants' main argument is that DirecTV does not show the positive limitation of protecting and unprotecting the segments of the set utilizing a correct key that is ... based at least in part on the identifier associated with a network address for the receiving device. See, claim 1, lines 2, 7, & 8.

**2.1.1.2.5 Page 21, 4<sup>th</sup> and 5<sup>th</sup> paragraphs**

The PTO claims that Appellants are arguing limitations not positively claimed. Appellants respectfully disagree.

Specifically, the PTO states "[a]ppellant does not claim that the each receiving device will have its own specific key which will be unique on the network." The PTO asserts that this is a claim limitation the Appellants are arguing.

Appellants agree that they are not claiming that each specific key be unique on the network. However, Appellants respectfully assert that this is not what they are arguing nor is it the main deficiency in the § 103 rejection.

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Appellants argue that neither Lewis, Hsu, nor DirecTV, either alone or in combination, suggests or describes protecting and unprotecting the segments of the set utilizing a correct key that is ... based at least in part on the identifier associated with a network address for the receiving device. See, claim 1, lines 2, 7, & 8. DirecTV instead shows an access card that must be activated prior to decrypting content. See DirecTV, page 15.

Appellants further argue that based upon DirecTV it is impossible to tell what DirecTV is doing (which makes DirecTV an improper reference because it does not meet the § 103 requirement to "teach or suggest all the claim limitations") but that based on reasonable speculation (speculation, which is not permitted under § 103) it is unlikely that DirecTV encodes (*i.e.* protects) their broadcast in such a way that there is a key associated with either a network address or an identifier on each card.

**2.1.1.2.6 Page 22, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs**

The PTO claims that Appellants are arguing limitations not positively claimed. Appellants respectfully disagree.

Specifically, the PTO states "[a]ppellant does not claim that [the] network address of each receiving device is used in the associated identifier." The PTO asserts that this is a claim limitation the Appellants are arguing.

Appellants agree that they are not claiming that the network address of each receiving device be used in the associated identifier. Appellants merely claim that the network address of each receiving device be associated with the associated identifier. See claim 1, line 2. However, Appellants respectfully assert that this is not what they are arguing.

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Appellants argue that neither Lewis, Hsu, nor DirecTV, either alone or in combination, suggests or describes protecting and unprotecting the segments of the set utilizing a correct key that is ... based at least in part on the identifier associated with a network address for the receiving device. See, claim 1, lines 2, 7, & 8. DirecTV instead shows an access card that must be activated prior to decrypting content. See DirecTV, page 15.

Appellants further argue that based upon DirecTV it is impossible to tell what DirecTV is doing (which makes DirecTV an improper reference because it does not meet the § 103 requirement to “teach or suggest all the claim limitations”) but that based on reasonable speculation (speculation, which is not permitted under § 103) it is unlikely that DirecTV encodes (*i.e.* protects) their broadcast in such a way that there is a key associated with either a network address or an identifier on each card.

### 2.1.1.3 Conclusion

It is respectfully asserted that the Code (35 U.S.C. § 103) does not allow prior art that may with hindsight possibly produce a limitation included within the claims. Instead, the Code specifies that the cited art must explicitly teach or suggest the limitation. It is respectfully asserted that all the DirecTV teaches is an access card, not a “correct key that is not generally available and is based at least in part on the associated identifier” with a network address. See, claim 1, lines 2, 7, & 8.

Under the requirements for §103, the prior art reference (or references when combined) must teach or suggest all the claim limitations. It is respectfully asserted that neither Lewis, Hsu, nor DirecTV, either alone or in combination, suggests or describes a receiving device having

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"correct key that is not generally available and is based at least in part on the associated identifier."

Therefore, even if the combination were proper, although Appellants believe that it is not, nonetheless, the combination would still fail to produce the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

#### **2.1.1.4 Remaining Claims**

Claims 2-16, and 19-32 either depend from and include the limitations of claim 1, or include a substantially similar and patentably distinct limitation as claim 1. Therefore, these claims patentably distinguish from the cited patents on the same basis as claim 1. It is, therefore, respectfully requested that the PTO withdraw the rejections of these claims.



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**2.1.2. Lewis, Hsu, DirecTV, & Robson: Claims 17 and 18**

The PTO has also rejected claims 17 and 18 under 35 U.S.C. § 103(a) on Lewis, Hsu, DirecTV and in combination with Robson. The rejection of these claims is also traversed.

Appellant does not see that the Examiner has added significant detail to the rejection via the Examiner's Answer. Therefore, all arguments in Appellants' Appeal Brief, filed December 12, 2005, are herein incorporated into this Reply Brief.

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### 3. CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,

/s/Justin B. Scout/Reg. No. 54,431/

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